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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.            | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------------|------------------|
| 10/045,803   | 01/12/2002  | Philip Connolly      | 7287                           | 3678             |
| 7590 12/02/2003  |             |                      |                                |                  |
| Paul M. Denk<br>763 South New Ballas Road<br>St. Louis, MO 63141 |             |                      | EXAMINER<br>HENDRICKS, KEITH D |                  |
|  |             |                      | ART UNIT<br>1761               | PAPER NUMBER     |

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                        |                                      |   |  |
|------------------------|--------------------------------------|---|--|
| <b>Advisory Action</b> | <b>Application No.</b><br>10/045,803 | <b>Applicant(s)</b><br>CONNOLLY, PHILIP |  |
|                        | <b>Examiner</b><br>Keith Hendricks   | <b>Art Unit</b><br>1761                 |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 30 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-3,7,8 and 10.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

## Attachment to Advisory Action

Continuation of 3. Applicant's reply has overcome the following rejection(s):

(A) 112 2nd par. and 102(e) rejections for canceled claims 11-18; and

(B) part (2) of the new rejection at page 3 of the Final Office Action only.

Also, all claim objections. All other rejections are maintained.

Continuation of 5: The request for reconsideration does not place the application in condition for allowance because: the claims were and are rejected for the reasons of record. At page 5 of the After-Final response, applicants state that "there are only two variables" in the claims. This is again not agreed with. Applicant may be reading limitations into the claim that are not present; however, the amount of bacteria in the composition is indeed specifically recited as a variable which contributes to the overall protein consumption of the subject, and is indeed part of the claimed invention which is "a combination of milk protein concentrates \*\*and probiotic bacteria\*\* in an amount sufficient to increase the subject's total daily consumption of protein". Both the milk protein concentrates and the probiotic bacteria are recited as contributing to this total protein amount. Along with "the subject's total daily consumption of protein", these create three variables within the claim. Applicants' statement that "the amount of protein per volume in the combined milk protein concentrates and probiotic bacteria will also be known", is incorrect, and is a primary basis for the 112 2<sup>nd</sup> paragraph rejection at hand. It is not apparent from the record upon what basis applicant may make this statement. These amounts are not known, are not provided in the claims, and thus render the metes and bounds of the claimed invention indefinite.

Regarding the prior art rejections (both 102 and 103 rejections remain), Applicants' arguments do not address the specific merits and teachings of the references, but simply state that none of the references "teach or suggest that it would be desirable to" provide the claimed milk protein concentrates and bacteria in the claimed amounts. However, as stated above and previously on the record, no such amounts are provided; applicants' arguments are based upon variables which do not actually yield a specific amount, and thus applicants' arguments that the reference does not teach a "desire" to provide a particular amount of these components, are not deemed persuasive. The lack of clarity of the claims and the difficulty in assessing the metes and bounds of the claimed invention in order to compare such to the prior art, has been previously addressed on the record. Simply put, the references anticipate and/or render obvious the claimed invention, as properly set forth previously on the record, unless applicant can demonstrate that the amounts provided in the reference are different, and unobvious, from the as yet unspecified "amounts" of the instant claims.

  
KEITH HENDRICKS  
PRIMARY EXAMINER